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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/739,034

Filing Date: December 14, 2000

Appellant(s): OBRECHT ET AL.

Jennifer R. Seng
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 21, 2008 appealing from the Office action mailed December 21, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

U.S. 6,127,488	Obrecht et al.	10-2000
U.S. 5,232,531	Dammann et al.	8-1993
DE 19701487	Eisele et al.	7-1998
JP 57-212239	Mizumoto et al.	12-1982

JP 5-17630 Iwakura et al. 1-1993

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Issue I: Rejection of Claims 8-10 and 23-32 Under 35 USC 112, First Paragraph

Claims 8-10 and 23-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Adequate support has not been provided for the amendment specifying that the rubber vulcanate or rubber body is non-adhesive. Appellants have stated that support stems from page 2, lines 9-13 of the specification (paragraph 5 of the published application); however, the argued citation refers to prior or known compositions, as opposed to the instant composition. Furthermore, the cited statement that prior or known compositions adhere to the metal parts of a mold in no way establishes that the instant composition lacks this property, even to a lessened degree. In the instant case, it is not seen how one can justify stating that their composition does not have a certain property simply because other compositions possess the property.

Additionally, appellants have in no way defined exactly what is meant by non-adhesive. Molding compositions, by their very nature, inherently possess some degree of adhesiveness; therefore, absent some language defining what is meant by the language, it cannot be determined exactly what degree of non-adhesiveness is encompassed by the language. Furthermore, the argued citation merely refers to the metal parts of molds; therefore, the citation in no way can be

construed to provide support for the composition being non-adhesive relative to other surfaces or substrates; however, the language of the amendment suggests exactly this.

Issue II: Rejection of Claims 8-10 and 23-32 Under 35 USC 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10 and 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obrecht et al. ('488) or DE 19701487, each in view of Dammann et al. ('531) or JP 57-212239 or JP 5-17630.

The primary references disclose rubber mixtures comprising double bond containing rubber and crosslinked rubber particles having appellants' claimed properties, wherein the mixtures are useful for producing vulcanisates and molded articles. See abstract; column 1, lines 31+; columns 2 and 3; and column 4, lines 49-59, within Obrecht et al. See abstract and page 4, line 3 within DE 19701487. Though the primary references are silent regarding the addition of a polyisocyanate component to the composition, the use of polyisocyanates within rubber mixtures to improve physical properties was known at the time of invention. This position is supported by the teachings of the secondary references. The secondary references disclose that polyisocyanate containing rubber formulations display excellent moldability and bonding resistant to heat and humidity. See abstracts. In view of the fact that appellants have failed to define "non-adhesive" and in view of the fact that the disclosures of the primary references disclose analogous

compositions and utilities to those of appellants, the position is taken that the primary references are similarly "non-adhesive" to the extent claimed or defined.

Therefore, it would have been obvious to incorporate polyisocyanates within the rubber mixtures of the primary references, so as to produce rubber compositions having the improved moldability and bonding characteristics taught by the secondary references. This position is bolstered by the fact that it has been held that it is *prima facie* obvious to utilize a known component for its art recognized purpose. In re Linder, 173 USPQ 356. In re Dial et al., 140 USPQ 244.

(10) Response to Argument

Response to Arguments Regarding Issue I

Appellants have argued that support stems from the fact that the disclosed prior art compositions have adhesive properties, whereas, since appellants use the instant composition in the production of molded articles that are non-adhesive, it follows that appellants' composition is inherently non-adhesive. In response, the position is maintained that neither adequate support nor adequate definition has been provided for the use of the term, "non-adhesive", as it pertains to the instantly claimed compositions. As aforementioned by the examiner, it is not seen that properties possessed by the disclosed prior art compositions are adequately supportive of properties possessed by or lacked by the instant compositions. That being said, the position is further taken that appellants' statement of the properties of the prior art do not necessarily follow the actual statements regarding such properties within the cited location of the specification. It is appellants' position that the vulcanates of the prior art are adhesive, in other words, sticky or tacky. However, the specification merely states that "the vulcanates adhere very greatly to the

metal parts of the vulcanizing molds that are used". This statement is not analogous to stating that the vulcanates (i.e.; the cured compositions) are adhesive (i.e.; sticky or tacky); the position is taken that one of ordinary skill would interpret this language of the specification as indicating that in the act of vulcanizing or crosslinking to become vulcanates, the curing composition had adhesive properties which caused adhesion or bonding to the mold surfaces. It simply cannot be deduced from the information provided that the prior art vulcanates (i.e.; the cured compositions) are adhesive or sticky or tacky once removed from the mold; however, this is appellants' contention. Accordingly, since the argument that the disclosed prior art vulcanates are adhesive does not appear to be supported by the specification, it is not seen how appellants' reliance on this suspect interpretation can serve as the basis of appellants' argument that the instant compositions are non-adhesive. Furthermore, appellants provide no clear definition or explanation of how the instant vulcanates are non-adhesive in that it is unclear if the curable compositions that yield the instant vulcanates are non-adhesive or not subject to adhering to mold surfaces. Lastly, since appellants have not actually defined or discussed the term, "non-adhesive", it cannot be determined if the "non-adhesive" property is an absolute property in that the composition is totally devoid of adhesive properties or if the property is a relative property in that the term is satisfied if the adhesive property is less than what is observed for the disclosed prior art compositions. On the face of it, the term, "non-adhesive" appears to require a total lack of adhesive properties; however, this is by no means clear in view of the argued disclosures within the specification. In summation, there simply is insufficient information provided within the specification that suggests that the instant vulcanates are non-adhesive or what actually constitutes a non-adhesive property as it relates to the instant compositions.

Response to Arguments Regarding Issue II

Appellants' arguments have been fully considered; however, the position is maintained that they are insufficient to overcome the prior art rejection. Appellants' arguments within pages 14 through 21 of the Appeal Brief can be summarized as follows: since the isocyanates of the secondary references are used within adhesive compositions, it would not have been obvious to incorporate such isocyanates within the primary references, because one would have expected an adhesive or composition having adhesive properties to result, and this is contrary to appellants' goal of producing a non-adhesive composition.

Firstly, contrary to appellants' assertions, not all of the secondary references are drawn to compositions disclosed as having adhesive properties. It is noted that the secondary reference, JP 57-212239, is drawn to compositions having high dynamic modulus after vulcanization and having excellent moldability. See abstract. Accordingly, it is not seen that appellants' arguments concerning adhesive properties are relevant to the obviousness rejection of the claims over the primary references in view of JP 57-212239. In view of the teachings within JP 57-212239, the position is taken that one would have reasonably expected improved physical properties and improved moldability to result from the incorporation of the polyisocyanate component of JP 57-212239 within the primary references, and it is not seen that appellants' arguments have rebutted this position. With respect to JP 57-212239, the following positions are taken. Firstly, appellants' claims are not seen to exclude masked polyisocyanates, and since the active group in polymerization or curing of polyisocyanates, including masked polyisocyanates, is the isocyanate group, one would reasonably expect the same properties to result from the use of masked or unmasked polyisocyanates. Secondly, appellants' claims do not exclude the

presence of the phenolic resin component of JP 57-212239; therefore, its presence is not relevant to the issues at hand. Accordingly, regardless of issues concerning adhesive properties, the position is taken that the instant claims are unpatentable over the combined teachings of the primary references and JP 57-212239.

Secondly, in response to appellants' fundamental argument that the rejection fails because one would have expected adhesive compositions to result from the inclusion of the polyisocyanate of the secondary references and that such a result is contrary to the requirements of the claims, the examiner takes the following position. As argued within Issue I, appellants have failed to clearly define exactly what properties are intended to be encompassed by or excluded by the term, "non-adhesive"; therefore, at best, it is difficult to discuss with certainty exactly how or to what extent the instant compositions are governed by the language. That being said, the position is taken that there is nothing encompassed by the argued limitation that necessarily distinguishes the claimed composition from the cured or vulcanized prior art compositions, because it has not been established that the cured or vulcanized prior art compositions are not non-adhesive to the extent instantly claimed. The examiner takes the position that in order for something to be adhesive, it must necessarily possess a degree of stickiness or tackiness or be able to adhere to something when it makes contact, and the position is taken that the argued prior art adhesive compositions possess this property prior to cure or vulcanization; however, once cured, thereby forming vulcanates, it is reasonable to conclude that while the property of adhesion (the bonding between materials) remains, the cured compositions are no longer adhesive, in that they lack the ability to further adhere to materials they contact once cured. It is important to note that the prior art largely discusses the compositions in the

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context of being uncured, since this is when they are usable or able to be applied and possess adhesive properties; however, in view of the fact that the claims require vulcanates or cured materials, it is proper to view the prior art materials in terms of them existing in their cured state. Despite appellants' arguments, taken in this context, it is entirely reasonable to expect that the prior art compositions, once cured would no longer be adhesive. The examiner takes the position that appellants' compositions prior to curing and the prior art uncured compositions modified in accordance with the position of the examiner would possess degrees of adhesiveness in much the same way that uncured epoxy glue possesses adhesiveness; however, once cured, the position is taken that it is reasonable to conclude that the modified prior art composition would be non-adhesive in much the same way that the cured epoxy would be non-adhesive. Accordingly, it is not seen that it is improper or unreasonable to rely on the teachings of the secondary references in the manner proposed by the examiner.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Rabon Sergent/
Primary Examiner, Art Unit 1796

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/James J. Seidleck/

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